

### **REMARKS**

Claims 1-28 and 33 are rejected. Claims 29-32, 34 and 35 are objected to. Claims 36-46 have been allowed. Claims 2-7, 21-35 and 46 have been amended. Claims 1, and 8-20 have been canceled. Claims 2-7, and 21-46 are presently pending in the application. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

#### **Allowable Subject Matter:**

The Applicants thank the Examiner for the allowance of Claims 36-46.

The Applicants have rewritten Claims 29-32, 34 and 35, which the Examiner objected to as being dependent upon a rejected base claim, but indicated would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In addition, the Applicant has amended "article" to "imaging element", based on previously presented Claims 36-46 and the specification as originally filed.

#### **Double Patenting:**

The Examiner has provisionally rejected Claims 1-5, 11, 13-18, 24, 26-28, 30, 36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 12-14, 29, 30, 33-37, 41-43, 45-51 of copending Application No. 10/008,810 ('810). The Applicants have included a terminal disclaimer in compliance with 37 CFR 1.321(c), as copending Application No. 10/008,810 ('810) is commonly owned with the present application.

#### **Rejection of Claims 8 and 21 under 35 USC § 112:**

Claims 8 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicants have deleted claim 8.

Claim 21 has been amended to reflect correct Markush language. In addition, the Applicants believe that the term "derivative", commonly defined as "(Chem.) A substance so related to another substance by modification or partial substitution as to be regarded as derived from it; thus, the amido compounds are derivatives of ammonia, and the hydrocarbons are derivatives of methane, benzene, etc." (Webster's Revised Unabridged Dictionary, 1913, pg. 395.) would

clearly indicate to those of ordinary skill in the art exactly what polyglutamic acid-based compounds are being claimed. In addition, 154 patent claims were identified for an imaging element which contain language relating to the "derivative" of a chemistry. For example, U.S. Pat. No. 6,645,690, claim 3 states "3. The photographic element of claim 1 wherein said flexibilizing agent is selected from the group consisting of polyhydric alcohols and their **derivatives**."; U.S. Pat. No. 6,620,577, claim 70 states "70. The photothermographic material of claim 50 further comprising a phthalazine or a phthalazine **derivative**."; U.S. Pat. No. 6,599,676, claim 8 states "8. The process of claim 1 wherein the at least one crosslinking resin is selected from the group consisting of resole resins, C (1)-C (5) alkoxymethyl melamine and glycoluril resins, poly (C (1)-C (5) alkoxy-methylstyrene), poly (C (1)-C (5) alkoxy-methylacrylamide) **derivatives** and combinations thereof."; U.S. Pat. No. 6,596,447, claim 11 states "11. The photographic element of claim 1 wherein said at least one layer comprising nacreous pigment above the image further comprises at least one polymer selected from the group consisting of polyurethane, polyester, acrylic, polycarbonates, acrylate latexes and copolymer **derivatives** thereof, carnauba wax, and/or fluoro-containing materials."; U.S. Pat. No. 6,558,884, claim 18 states "18. The imaging element of claim 2 wherein the acid component other than terephthalic acid in the PET-based polyester material is selected from the group consisting of isophthalic acid, 1,4- cyclohexanedicarboxylic acid, paraphenylenedicarboxylic acid, naphthalenedicarboxylic **acid and derivatives** thereof."; U.S. Pat. No. 6,403,527, claim 7 states "7. Process according to claim 6, wherein said 3,4- dihydroxyphenyl compound is selected from the group consisting of gallic **acid derivatives**, gallates, ethyl 3,4-dihydroxybenzoate, butyl 3,4- dihydroxybenzoate, 3,4-dihydroxy-benzoic acid and 3,4- dihydroxybenzonitrile."; U.S. Pat. No. 6,207,614, claim 1 states "1. A substantially light-insensitive black and white monosheet thermographic recording material comprising a support and a thermosensitive element which is optionally provided with a protective layer, wherein said thermosensitive element contains substantially light- insensitive mixed crystals of at least one organic silver salt and at least one organic fatty **acid derivative**, an organic reducing agent for said organic silver salt in thermal working relationship therewith and a binder and wherein said substantially light-insensitive mixed crystals are present

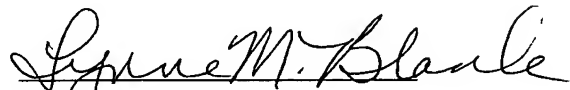
in an inner layer of said thermographic recording material.”; and U.S. Pat. No. 6,165,702, claim 2 states “2. The imaging element of claim 1, wherein the water insoluble lubricant is selected from the group consisting of silicone based materials, fatty acids, fatty **acid derivatives**, alcohols, alcohol **derivatives**, fatty acid esters, fatty acid amides, polyhydric alcohol esters of fatty acids, paraffin, carnauba wax, natural waxes, synthetic waxes, petroleum waxes, mineral waxes, perfluoro-containing materials, fluoro-containing materials, and fluorochloro-containing materials.” The Applicant believes that the use of the term “derivative” is common definite language used in allowable patent claims and request that the Examiner reconsider the rejection.

**Rejection of Claims 1-7, 9-28, 30 and 33 Under 35 U.S.C. §102(e):**

The Examiner has rejected Claims 1-7, 9-28, 30 and 33 under 35 U.S.C. 102(e) as being anticipated by FISHER (US 6,579,927). The Applicants request withdrawal of the rejection, as Claims 1-7, 9-28, and 30 have been deleted. The Applicants request reconsideration of Claim 33 in light of its dependency on Claim 32, indicated as allowable if rewritten in independent format as discussed above.

It is believed that the foregoing is a complete response to the Office Action and that the claims are in condition for allowance. Favorable reconsideration and early passage to issue is therefore earnestly solicited.

Respectfully submitted,

  
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